

Appl. No. 10/076,609
Amdt. dated ***July 22, 2004***
Reply to Office Action of Mar. 23, 2004

REMARKS

Applicants appreciate the Examiner's thorough review and consideration of their application. Applicants respectfully request the Examiner to reconsider and withdraw the objections and rejections, and then pass this application on to allowance.

Amended claims 1, 5 and 9 reflect the self-evident spelling, wording or idiomatic matters noted by the Examiner. It is respectfully submitted that edits to terms, such as "an" to "a" or, for instance, "thermoplastic" to "molten synthetic resin", are consistent with the original claims and how a person skilled in the art would have read them. It is respectfully submitted that these minor edits do not contract claim scope.

New claim 15 is based on the specification throughout and the original claims. Attention is respectfully invited to page 20, lines 8-11, among other passages. It is therefore submitted that such claim finds antecedent enabling support in the original specification and that there is no new matter.

 The attached Declaration establishes common ownership and/or an obligation to assign to a common entity in accordance with 37 C.F.R. §1.78(c) and 35 U.S.C. § 103(c).¹

The claims comply with 35 U.S.C. §112(¶ 1). Applicants respectfully request that the rejection of claims 1-4 at numbered paragraph 4 in the Office Action be withdrawn. The Office Action cites the specification at page 18, lines 18-22. However, that is only a snippet of the disclosure. A person skilled in the art would have recourse to the complete disclosure and certainly at least the full paragraph that bridges pages 18-19. Applicants respectfully

¹ The assignee name is printed on the face of U.S. Patent No. 6,413,461B1 and the same entity is the assignee of the present application. The latter is thought to be *prima facie* shown by the assignments of record. It is assumed that the assignments of record - or at least the identity of the assignee - are available to the Examiner via the PTO's "PALM" system and/or "PAIR." Therefore, even without a signed Declaration, all prior art rejections over USP '461B1 that rely in whole or in part on 35 U.S.C. §102(e) should be reconsidered and withdrawn in view of the AIPA.

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request reconsideration and withdrawal of the rejection of claims 1-4 in numbered paragraph 5 in the Office Action. The Office Action cites to page 20, lines 8-11 and offers the opinion that the half-opening operation is carried out within one second, otherwise the claims are not enabled. The rejection should not have been made in the first instance. The Examiner is respectfully invited to re-read claim 1. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 9-11 in numbered paragraph 6 in the Office Action. The Office Action cites page 18, lines 18-22. It is only a snippet of the disclosure. Applicants respectfully submit that the person skilled in the art would read the complete specification, and that includes the full paragraph that bridges pages 18-19. It is respectfully submitted that the full disclosure teaches that the length of the primary cooling is a function of various factors and provides guidance. The claims reasonably define the scope of the inventions and the specification teaches how to practice the inventions, not the other way around. The rejection of claims 9-11 in numbered paragraph 7 in the Office Action should be reconsidered and withdrawn. The Examiner is respectfully directed to the specification at pages 20 to 25, line 7 and to claim 9, last clause.

Applicants respectfully submit that there is no *prima facie* case of obviousness type double patenting of claim 1 over claims 1 and 2 of U.S. Patent No. 6,413,641; there is no *prima facie* case of obviousness type double patenting of claim 9 over claims 1 and 2 of U.S. Patent No. 6,413,461; there is no *prima facie* case of obviousness of claims 1-4 under 35 U.S.C. §103(a) over U.S. Patent No. 6,413,461; there is no *prima facie* case of obviousness of claims 9-11 under 35 U.S.C. §103(a) over U.S. Patent No. 6,413,461; there is no *prima facie* case of obviousness of claims 1-4 under 35 U.S.C. §103(a) over EP 0955143A2; and there is no *prima facie* case of obviousness of claims 1-4 under 35 U.S.C. §103(a) over EP 0955143A2.

Applicants draw attention to In re Rouffet, 149 F.3d 1350-1357-58 (Fed. Cir. 1998), wherein the Federal Circuit reversed rejections because the Patent Office did not provide evidence why a person of ordinary skill in the art at the time the inventions on appeal were

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made, such person having no knowledge of the invention, would have found the invention obvious. Particularly germane is the decision of In re Lee, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002), wherein the Federal Circuit reversed rejections and stressed “[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.” In particular, the Federal Circuit’s admonition in the Lee case seems apposite to the present situation:

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

In re Lee, 277 F.3d at 1344-45

Applicants acknowledge with appreciation that the Office Action has established that U.S. Patent No. 6,413,461 "does not teach forming the gap between the pair of male female mold halves by adjusting in increments of 0.1 mm" Office Action, page 8. The Office Action similarly states that "Kobayashi et al. [EP 0955143A2] do not teach forming the gap between the pair of male female mold halves by adjusting in increments of 0.1 mm." Office Action, page 17. It is noted that such feature is included in claim 9 and claim 15.

Applicants acknowledge with appreciation that the Office Action has established that U.S. Patent No. 6,413,461 "does not teach opening the mold halfway in no more than one second." Office Action, page 10. The Office Action similarly states that "Kobayashi et al. [EP 0955143A2] do not teach opening the mold in no more than one second." Office Action, pages 15 and 16. It is noted that such feature is included in claim 1 and claim 15.

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The cited U.S. Patent No. 6,413,461 and the cited EP 0955143A2 do not disclose nor teach the inventions defined by the elected claims. It is also specifically noted that the claims in the aforementioned U.S. Patent No. 6,413,641 when taken as a whole would not have suggested the inventions defined by the claims herein, especially where, as here, the patent claims do not and would not have suggested elements of the present claimed inventions.

The Office Action nonetheless expresses the view that which is neither disclosed nor taught by the cited art is somehow “well-known in the molding art.” Applicants respectfully traverse and respectfully invite the Examiner to submit his Declaration to supply the facts missing from the record. Otherwise, Applicants earnestly, but most respectfully, request the Examiner to withdraw all rejections.

Applicants have endeavored to address all matters but if an aspect of the Office Action was overlooked, please contact the undersigned so that all matters can, as they should, be resolved to the Examiner’s satisfaction.

Applicants earnestly, but respectfully, submit their application is in condition for allowance.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: 
Kendrew H. Colton
Registration No. 30,368

Customer No. 42798

FITCH EVEN TABIN & FLANNERY
1801 K Street, N.W. - Suite 400L
Washington, D.C. 20006-1201
Telephone: (202) 419-7000
Facsimile: (202) 419-7007



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/076,609 Confirmation No. 2309
Applicant : KITAYAMA et al.
Filed : February 19, 2002
TC/A.U. : 1732
Examiner : Edmund Lee
For : PROCESS FOR PRODUCING MULTILAYER MOLDED ARTICLE

Docket No. : 7388/72610
Customer No. : 22242

DRAFT

DECLARATION UNDER 37 CFR 1.78(c)

Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Dear Sir:

Sumitomo Chemical Co., Ltd. hereby states that it is the assignee named on U.S. Patent No. 6,413,461 and that the inventions claimed therein were commonly owned or subject to an obligation of assignment to the same entity, e.g. the same assignee, at the time the inventions claimed in this application were made, and further that said same entity is Sumitomo Chemical Co., Ltd., which is in accord with the assignment of this application to Sumitomo Chemical Co., Ltd., which assignment has been recorded at reel/frame 013162/0954 on August 2, 2002.

The undersigned has the authority to execute this document on behalf of Sumitomo Chemical Co., Ltd.

SUMITOMO CHEMICAL CO., LTD.

By _____
Name: _____

Date: _____